REMARKS

Claims 1-3, 5-10, and 12-15 remain of record in this application. Claims 3, 5, 10, and 12 have been amended. No claims have been canceled and no new claims have been added by this amendment.

Entry of the amendment is requested to reduce the issues on appeal, specifically to overcome the rejection of claims 3, 5, 10, and 12 under 35 U.S.C. 112, second paragraph. The amendment was not presented earlier because the rejection was newly presented in the last office action. **In the event that entry of this amendment is denied, Applicants respectfully request that the finality of the last office action be withdrawn.** The rejection of claims 3, 5, 10, and 12, was newly presented, despite the presence of these claims, in their rejected form, in the application as originally filed.

Support for the amendments to the claims is inherent in the original disclosure. Claims 3, 5, 10, and 12 have simply been amended to delete a clause objected to by the Examiner in the latest office action.

Telephonic Conversation

On February 8, Applicants' representative, Randall Deck, called Examiner McGaw to request clarification of the status of claims 3 and 10. Specifically, Applicants' representative noted that the claims were not cited in the rejections over the prior art, and questioned if the claims were free of the prior art. Examiner McGaw indicated that the claims had not been included in the §103 rejections because they were indefinite (referring to the §112 rejections). Applicants' representative explained that the claims were drawn to product-by-process limitations, whereupon the Examiner indicated that the claims should be considered obvious over the prior art.

Rejection Under 35 U.S.C. 112

Claims 3 and 8-13 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Each of the issues raised by the Examiner are addressed hereinbelow.

A. Claims 3, 5, 10, and 12 have been rejected as indefinite in reciting the phrase "all of the identifying characteristics" of strain ATCC PTA-4945. Applicants respectfully disagree.

A detailed description of the production of the strain referred to in the claim, Marek's disease virus ATCC PTA-4945, is provided in Example 1 in the specification. In brief, the strain was produced by insertion of the long terminal repeat sequence (LTR) from a reticuloendotheliosis virus into the genome of a well-known, established Marek's disease virus, strain CVI988. Both the LTR and the CVI988 strain are either well described or well-known in the art, and the techniques and location of the insertion of the LTR into the CVI988 genome are fully described. Thus, Applicants submit that a practitioner skilled in the art would be well aware of the "identifying characteristics" of the deposited and claimed strain. Moreover, the claimed strain has been deposited in the American Type culture Collection under the Budapest Treaty and will become available, without restriction, upon the granting of the patent. Thus, any practitioner skilled in the art could readily determine the "identifying characteristics" of this strain.

However, in an effort to expedite prosecution and reduce the issues on appeal, the terminology objected to has been removed from the claims.

B. Claims 3 and 10 have been rejected as indefinite in reciting the use of a *PacI* excised fragment. The Examiner has indicated that the identity of the particular restriction site would appear to be irrelevant, especially since the site would be lost during recombination. Applicants respectfully disagree.

Applicants believe that the remarks presented in response to this argument in the previous amendment are still appropriate and are therefore repeated.

Moreover, it is well established that product claims may include process steps to wholly or partly define the claimed product. See *In re Hallman* (CCPA 1981) 210 USPQ 609, *In re Luck et al.* (CCPA 1973) 177 USPQ 523, and *Ex parte Calhoun et al.* (POBA 1976) 195 USPQ 455. Claims 3 and 10 recite process limitations describing that the long terminal repeat "comprises a *Pac* I excised DNA segment from Marek's disease virus strain ATCC PTA-4945." In other words, the claim describes how the LTR was obtained from the deposited MDV strain. Applicants respectfully submit that a practitioner skilled in the art would have no difficulty understanding this step, and thus the process limitations of claims 3 and 10 are clearly proper.

Rejection Under 35 U.S.C. 103

Claims 1-3, 5-10, 2, 5-7, 9, 12, and 13 have been rejected under 35 U.S.C. 103 as being unpatentable over Witter *et al.* (1997) in view of Witter *et al.* (1995) and Jones *et al.* (1996). Applicants respectfully disagree.

Applicants believe that the response to this rejection in the previous amendment is still appropriate and is therefore repeated.

In addition to the arguments previously presented, Applicants believe that dependent claims 3 and 10 further differentiate over the prior art of record. As noted above, claims 3 and 10 recite process limitations describing that the long terminal repeat of the independent claims "comprises a *Pac* I excised DNA segment from Marek's disease virus strain ATCC PTA-4945." This is not disclosed or suggested in the prior art of record.

Even if the prior art did suggest inserting an LTR from a reticuloendotheliosis virus into a Marek's Disease virus as proposed by the Examiner (a point which is not conceded by Applicants for the reasons previously noted), the prior art certainly provides no teaching whatsoever how that should be done. It is only by virtue of Applicants' disclosure that a

practitioner of ordinary skill in the art would excise the LTR from Applicants' deposited strain using *Pac* I restriction sites as claimed.

For the reasons stated above, claims 1-3, 5-10, and 12-15 are believed to satisfy the requirements of 35 U.S.C. 112 and distinguish over the prior art of record. Entrance of this amendment and allowance of the application is respectfully requested.

Respectfully submitted,

Randall E. Deck, Agent of Record
Registration No. 34,078

Peoria, IL

309/681-6515
FAX: 309/681-6688
202/720-2421